

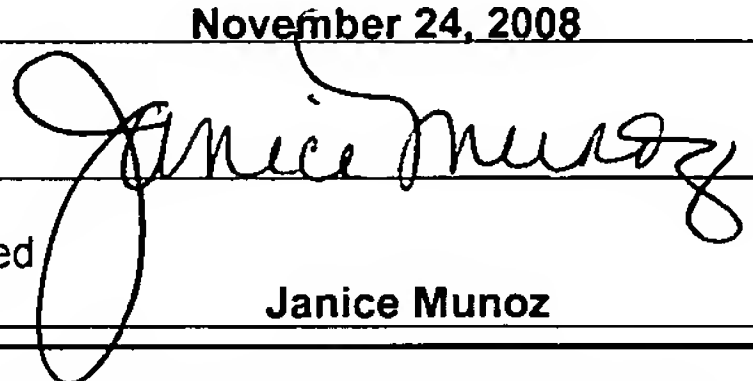
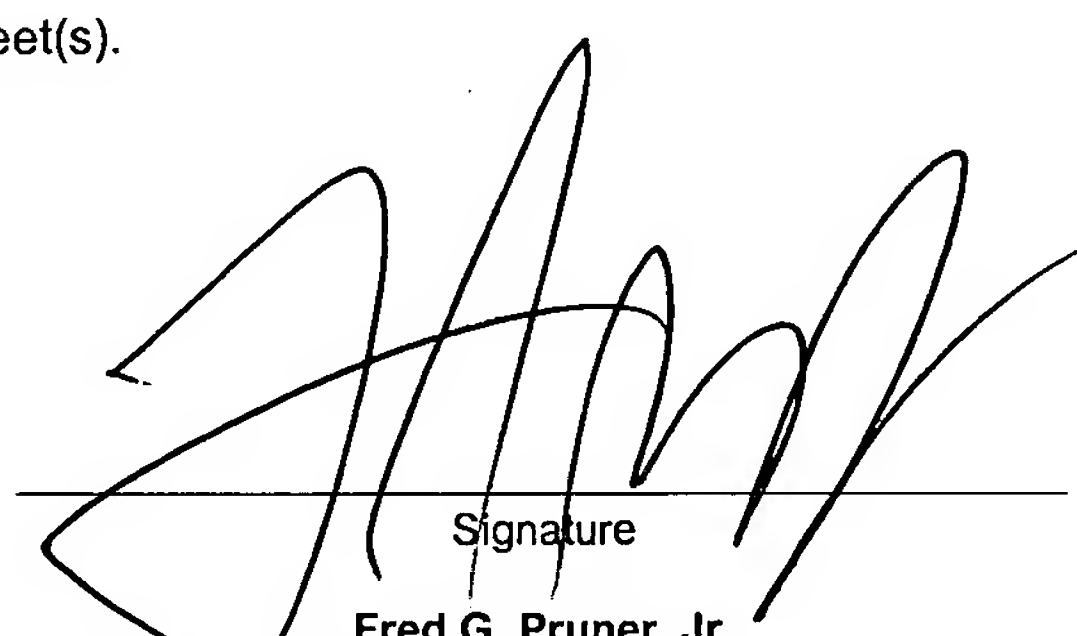
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PTO/SB/33 (08/08)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		68.0322US (SHL.0238US)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>November 24, 2008</u> Signature <u></u> Typed or printed name <u>Janice Munoz</u>		Application Number	Filed
		10/708,517	03/09/2004
		First Named Inventor	
		CRAIG D. JOHNSON	
		Art Unit	Examiner
		3679	Aaron M. Dunwoody
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Fred G. Pruner, Jr.	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>40,779</u>		Typed or printed name	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		(713) 468-8880	
		Telephone number	
		November 24, 2008	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Applicants: Craig D. Johnson et al.

Serial No.: 10/708,517

Filed: March 9, 2004

Title: JOINING TUBULAR
MEMBERS

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Art Unit: 3679

Examiner: Aaron M. Dunwoody

Docket No. 68.0322US
(SHL.0238US)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant seeks pre-appeal review of the rejections of claims 1-3, 4, 7, 11, 12, 16, 18, 22, 97 and 99-103. In a Final Office Action mailed on August 22, 2008, claims 1-3, 5, 7, 11, 12, 16, 18, 22, 97 and 99-103 were rejected under 35 U.S.C. § 112, second paragraph; and claims 1-3, 5, 7, 11, 12, 16, 18, 22, 97 and 99-103 were rejected under 35 U.S.C. § 102(b)-as being anticipated by Phipps.

Regarding the § 112, second paragraph rejections, Applicant respectfully submits that the Examiner has failed to set forth a proper basis for any of the § 112, second paragraph rejections. The rejections appear to be based on the failure of the claims to incorporate the first and second tubings as explicit elements. For example, the apparatus of independent claim 1 recites a body that includes a first opening to receive a first tubing section and a second opening to receive a second tubing section. However, claim 1 does not include the first and second tubing sections as explicit elements. It is noted that the Examiner states on page 2 of the Office Action, "the Examiner must conclude that the first and second tubing sections are considered part of the

Date of Deposit: November 24, 2008

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Janice Munoz

claimed invention," in page 2 of the Office Action but later states on page 3 of the Office Action, "note, the first and second tubing sections are not considered part of the claimed invention."

Applicant respectfully submits that claims 1 and 2 meet the requirements of 35 U.S.C. § 112, which has two general requirements: 1.) the claims must set forth the subject matter that Applicant's regard as their invention; and 2.) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. M.P.E.P. § 2171. The Office Action fails to specifically point out why the claims do not comply with these two requirements. It appears the claims may be improperly rejected on the basis that the claims omit essential matter. However, such a basis would be improper, as the Examiner has not shown where in the specification or statement of record the Applicant has deemed the first and/or second tubing sections to be essential to the invention. M.P.E.P. § 2172.01. In view of the foregoing, Applicant respectfully requests withdrawal of the § 112, second paragraph rejections.

Regarding the § 102 rejections, the apparatus of claim 1 recites that the tubular member includes a passageway adapted to align with the passageway of the body of the connector such that a gap exists between the passageway of the body and the passageway of the tubular member when both the first and second tubing sections are fully received in the first and second openings of the body, and the sleeve is in the retracted position.

The Office Action fails to label numerous specific elements of claim 1 that are purportedly disclosed in Phipps, as only elements that purportedly correspond to the sleeve, sealing element and tubular member have been labeled. Without a clearer statement of the § 102 rejections from the Examiner, Applicant cannot fully address the § 102 rejections. It is noted that the structure disclosed in Phipps does not appear to meet the claim limitations for at least the reason that the threaded collar 52 (the alleged sleeve) is apparently incapable of being retracted when the purported first and second tubing sections are fully received in first and second openings of a body that is adapted to receive first and second tubing sections. For at least this reason, Phipps fails to anticipate independent claim 1.

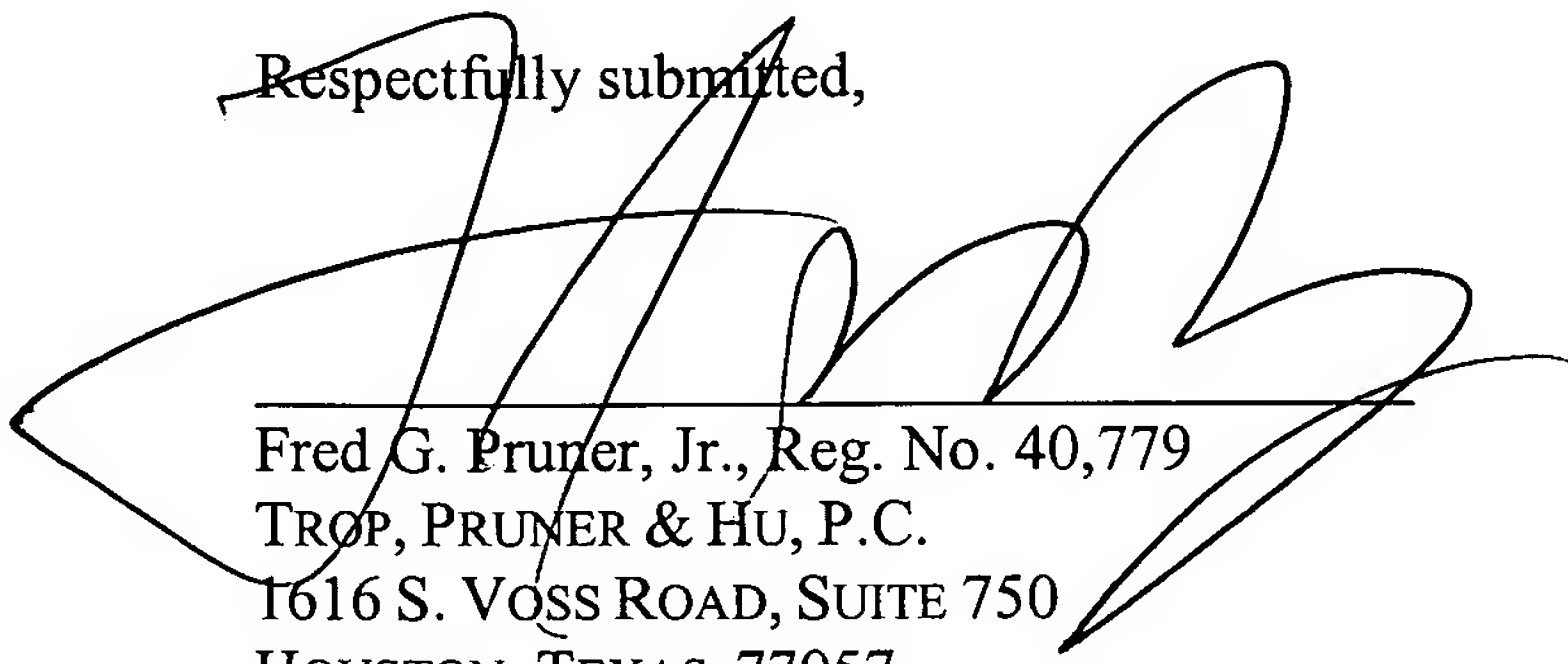
Phipps fails to anticipate either independent claim 97 or 101 for at least the same reasons. In this regard, Phipps fails to disclose at least the sleeve being in a retracted position when first and second tubing sections are fully received in first and second openings of a body, as recited in independent claims 97 and 101. Dependent claims 2, 3, 11, 12, 16, 18, 22, 99, 100, 102 and 103 are patentable for at least the reason that these claims depend from allowable claims.

CONCLUSION

In view of the foregoing, Applicant respectfully requests withdrawal of the §§ 102 and 112 rejections and a favorable action in the form of a Notice of Allowance. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0238US).

Respectfully submitted,

Date: November 24, 2008



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